

AMENDMENTS AND REMARKS

This reply is fully responsive to the Office Action dated 6 OCTOBER 2006, and is filed
5 within six - (6) months following the mailing date of the Office Action. The
Commissioner is authorized to treat this response as including a petition to extend the
time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number
of months necessary to make this response timely filed. The method of payment and fees
for petition fee due in connection therewith is enclosed.

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Disclosure/Claims Status Summary:

This application has been carefully reviewed in light of the Office Action of October 6,
15 2006, wherein:

- A. The rejections of Claims 1-16 under 35 U.S.C. § 101 were withdrawn;
- B. Claims 1-16 were objected to because of informalities;
- C. Claims 1-16 were rejected under 35 U.S.C. § 112, second paragraph, as being
indefinite for failing to particularly point out and distinctly claim the subject matter
20 which Applicant regards as the invention; and
- D. Claims 1-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mahoney
et al.

Please note that, in order to facilitate the reading of this Office Action
25 Response, **all the statements submitted by the Applicants have been
indented while the Examiner's statements (presented in the Office
Action dated 6 OCTOBER 2006) are not indented.**

Furthermore, please note that the amendments to Claims 1-16, proposed
30 below on this response, have been made in order to correct typographical
and antecedent basis issues and do not affect the scope of the claims.
Furthermore, some of these amendments have been made to increase

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claim readability, to improve grammar, and to reduce the time and effort required of those skilled in the art to clearly understand the scope of the claim language. The Applicants respectfully request that the Examiner accept the newly amended set of claims as a replacement for the original set of claims submitted with the patent application. The Applicants believe this new set of amended claims overcome the objections and rejections cited by the Examiner.

Claim Objections

In the third section of the current Office Action, the Examiner objected to Claims 1-16 based upon several informalities and typographical mistakes.

Objections to Claims 2-8

The Examiner objected to Claims 2-8 for lacking sufficient antecedent basis. Specifically, the Examiner stated that independent Claim 1 is directed to “An apparatus for automatically” in the preamble, later on, dependent Claims 2-8, introduce the statement of “An apparatus according to Claim 1” making it vague and unclear to the Examiner if a new apparatus separate from the proceeding one, takes place, after the initial process or if the claims are meant to be independent claims and therefore should be written as such. The Examiner further stated that if Claims 2-8 are dependent claims that disclose the same apparatus as the apparatus introduced in the independent Claim 1 of which they depend, then the dependent Claims 2-8 must be modified from “An apparatus ... as set forth in Claim 1” to read as “The apparatus ... as set forth in Claim 1.”

Regarding objections to Claims 2-8

The Applicants agree with the Examiner’s assessment that this is a typographical mistake. Therefore, in order to correct typographical and antecedent basis issues, the Applicants have amended Claims 2-8 by replacing “An apparatus ... as set forth in Claim 1” to read as “The

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apparatus ... as set forth in Claim 1.” The Applicants refer the Examiner to pages 2 and 3 of this response, where a new listing of claims is provided containing the after mentioned amendments.

5 The Applicants sincerely thank the Examiner for discovering these typographical mistakes, and will thoroughly review the application to find any other mistakes that may be present. Upon discovery of any additional mistakes, the Applicants will immediately contact the Examiner with the appropriate correction(s).

10 The Applicants respectfully request that the Examiner accept the newly amended set of claims as a replacement for the original set of claims submitted with the patent application. The Applicants believe this new set of amended claims overcomes the objection cited by the Examiner
15 regarding Claims 2-8, and therefore respectfully request that the Examiner withdraw this objection of Claims 2-8.

Objections to Claims 10-16

20 The Examiner objected to Claims 10-16 for lacking sufficient antecedent basis. Specifically, the Examiner stated that independent Claim 9 is directed to “A method for automatically” in the preamble, later on, dependent Claims 10-16, introduce the statement of “A method according to Claim 9” making it vague and unclear to the Examiner if a new method separate from the proceeding one, takes place, after the
25 initial process or if the claims are meant to be independent claims and therefore should be written as such. The Examiner further stated that if Claims 10-16 are dependent claims that disclose the same method as the method introduced in the independent Claim 9 of which they depend, then the dependent Claims 10-16 must be modified from “A method ... as set forth in Claim 9” to read as “The method ... as set forth in Claim 9.”

Regarding objections to Claims 10-16

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5 The Applicants agree with the Examiner's assessment that this is a typographical mistake. Therefore, in order to correct typographical and antecedent basis issues, the Applicants have amended Claims 10-16 by replacing "A method ... as set forth in Claim 9" to read as "The method ... as set forth in Claim 9." The Applicants refer the Examiner to pages 4 and 5 of this response, where a new listing of claims is provided containing the after mentioned amendments.

10 The Applicants respectfully request that the Examiner accept the newly amended set of claims as a replacement for the original set of claims submitted with the patent application. The Applicants believe this new set of amended claims overcomes the objection cited by the Examiner regarding Claims 10-16, and therefore respectfully request that the Examiner withdraw this objection of Claims 10-16.

15 **Objection to Claim 1**

The Examiner objected to Claim 1 for missing a semicolon. The Examiner stated that a semicolon is missing in Claim 1, line 3, after the recitation of "wherein" in order to clearly distinguish the preamble and the body of the claim.

20 **Regarding missing semicolon in Claim 1**

25 The Applicants partially agree with the Examiner's assessment that this is a typographical mistake. Therefore, the Applicants have amended Claim 1 to include a colon (and not a semicolon as the Examiner suggested) by replacing the word "wherein," to read as "wherein:" in Claim 1. The Applicants refer the Examiner to pages 2 of this response, where a new listing of claims is provided containing the after mentioned amendment.

30 The Applicants respectfully request that the Examiner accept the newly amended set of claims as a replacement for the original set of claims submitted with the patent application. The Applicants believe this new set

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of amended claims overcomes the objection cited by the Examiner regarding Claim 1, and therefore respectfully request that the Examiner withdraw this objection of Claim 1.

5 **Objection to Claims 1 and 9**

The Examiner objected to Claims 1 and 9 for utilizing the word “using” which carries no patentable weight. The Examiner stated that Claims 1 and 9 recite the limitation “using” which constitute intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to be patentable. Then, the Examiner concluded that the word “using” carries no patentable weight, and that the intended use recitation in the claims never has to occur. The Examiner further concluded that the claims should be amended to recite more firm and positive language (i.e. “based on,” “of,” “is,” “to,” “wherein,” “employing,” or “providing”), and the Examiner requested that an appropriate correction be made.

Regarding objection to Claims 1 and 9

The Applicants have amended Claim 1 by replacing the word “use” to read as “employ”, and amended Claim 9 by replacing the word “using” to read as “employing.” The Applicants refer the Examiner to pages 2 and 4 of this response, where a new listing of Claims 1 and 9, respectively, is provided containing the after mentioned amendments.

The Applicants respectfully request that the Examiner accept the newly amended set of claims as a replacement for the original set of claims submitted with the patent application. The Applicants believe this new set of amended claims overcomes the objection cited by the Examiner regarding Claims 1 and 9, and therefore respectfully request that the Examiner withdraw this objection of Claims 1 and 9.

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Objection to Claims 5 and 13

The Examiner objected to Claims 5 and 13 for utilizing the phrase “can be” which carries no patentable weight. The Examiner stated that Claims 5 and 13, recite the limitation “can be,” and that “can be” is indirect, suggest optionally, and passive which renders any recitation claimed after not be given patentable weight. Then, the Examiner requested that an appropriate correction be made, and that the claims be amended to recite “is” or “will be” instead of “can be.”

Regarding objection to Claims 5 and 13

The Applicants agree with the Examiner’s assessment. Therefore, the Applicants have amended Claims 5 and 13 by replacing the words “can be” to read as the word “is” in Claims 5 and 13. The Applicants refer the Examiner to pages 3 and 5 of this response, where a new listing of Claims 5 and 13, respectively, is provided containing the after mentioned amendments.

The Applicants respectfully request that the Examiner accept the newly amended set of claims as a replacement for the original set of claims submitted with the patent application. The Applicants believe this new set of amended claims overcomes the objection cited by the Examiner regarding Claims 5 and 13, and therefore respectfully request that the Examiner withdraw this objection of Claims 5 and 13.

Claims Rejections - 35 USC § 112, second paragraph

In the fifth section of the current Office Action, the Examiner rejected Claims 1-16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Rejection of Claim 1 under 35 U.S.C. § 112, for using “is further configured”

The Examiner stated that in Claim 1, line 4, the recitation of “is further configured” renders the claim to be indefinite for failing to particularly point out and distinctly claim

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the subject matter which applicant regards as the invention. The Examiner further stated that it is unclear to the Examiner what the first processing element was initially configured to perform, or how else the first processing element can be configured. Next, the Examiner suggested that Claim 1 should be amended to recite, "is configured" deleting
5 the word "further."

With regards to the Applicants' response, filed on July 5, 2006 and March 6, 2006, where the Applicants submitted that "further configured" is proper since it shows the degree that the processing element is configured to, the Examiner contended that there is no showing
10 of an initial configuration in order for the word "further" to be grammatically correct English, in light of the claim language, and in order to be given clear meaning, since it suggest the first processing element is missing element/step that must have been first configured with, in order to have a "further configuration" as suggested by the claim language. The Examiner further stated that there can be no additional "degree" attributed
15 to the first processing element without any prior basis. Next, the Examiner suggested deleting the word "further" in order to provide clarity to the claims.

Regarding Claim 1 rejection for using "is further configured"

In order to correct typographical and antecedent basis issues, the
20 Applicants have amended Claim 1 by deleting the word "further," thus replacing the words "is further configured" to read as the words "is configured" in Claim 1. The Applicants refer the Examiner to page 2 of this response, where a new listing of Claim 1 is provided containing the after mentioned amendment.

25 In light of the amendment and the remarks made above, the Applicants believe Claim 1 to be allowable in its present form, and respectfully request that this rejection of Claim 1 under the second paragraph of 35 U.S.C. § 112 be withdrawn.

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Rejection of Claim 1 under 35 U.S.C. § 112, for using “to also provide”

The Examiner stated that in Claim 1, line 12, the recitation of “to also provide” renders the claim to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner further stated that
5 it is unclear to the Examiner how else is the database configured to do or what other steps is the database providing. Furthermore, the Examiner stated that Claim 1 should be amended to recite “database is configured to provide” by deleting the word “also.”

With regards to the Applicants’ response, filed on July 5, 2006 and March 6, 2006, where
10 the Applicants submitted that “to also provide” has a clear distinction in the claims, the Examiner stated that, “in this case, as clearly stated by the Applicant’s remarks on page 6, the second processing element is the one providing the input, thus making it difficult for the Examiner to understand the role that the database is contributing.” The Examiner further stated that “it is not clear from the claim language that the database is providing
15 input in addition to the second processing means, and that it is initially understood from the claim language that the database has provided initial input and now is providing more. Then, the Examiner suggested that a clarification to the claim language would be helpful.

Regarding Claim 1 rejection for using “to also provide”

The Applicants agree with the Examiner’s assessment that this is a typographical mistake. In order to correct typographical and antecedent basis issues, the Applicants have amended Claim 1, line 12 by deleting the word “also,” thus replacing the words “to also provide” to read as the
25 words “to provide.” The Applicants refer the Examiner to page 2 of this response, where a new listing of Claim 1 is provided containing the after mentioned amendment.

In light of the amendment and the remarks made above, the Applicants
30 believe Claim 1 to be allowable in its present form, and respectfully

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request that this rejection of Claim 1 under the second paragraph of 35 U.S.C. § 112 be withdrawn.

Rejection of Claim 1 under 35 U.S.C. § 112, for “unclear difference between predetermined information and metadata”

The Examiner stated that Claim 1, line 9, recites the limitation “extract predetermined information” and the claim further recites “extracting metadata,” and it is unclear to the Examiner what the difference between the two claimed limitations, if any, exist, and if there's a clear and precise difference then the Examiner suggest that it should be disclosed in the claim, otherwise it renders the claim to be indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner further stated that the Examiner does not find a clear definition of the “extracted predetermined information” in the specification, and that Claim 1 needs to be amended to show this distinct difference.

Furthermore, the Examiner stated that it is unclear to the Examiner how the two sets of extracted information/metadata are linked together in order to perform the steps of the claimed invention. The Examiner stated that “if there's a clear and precise difference then it should be disclosed in the claim” and that in the specification a definition of “extracting predetermined information” is merely stated as “extracting the desired information” (referring to specification paragraph 0063) and only stated as such in paragraph 0069 under “another embodiment” of the invention and not stated in the overall invention or the preferred embodiment.

With regards to the Applicants' response, filed on July 5, 2006 and March 6, 2006, where the Applicants submitted that “the distinction is clear in the claims between the extracted predetermined information and the metadata,” the Examiner stated that “if extract predetermined information is being done from the files, then that a clarification is needed in the claim to that effect.” The Examiner further stated that “if the predetermined information is different from the metadata, then that distinction should be made clear in the claims, since both can be the same information in light of Applicant's previous

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response. The Examiner stated that “if such distinction was pertinent to the claim language it should be made clear in the claims.”

Furthermore, the Examiner stated that the Applicants previously stated that “the extracted
5 predetermined information is used to extract the metadata,” but that this was not clearly stated or presented as such in the independent claims. The Examiner further stated that there appears to be no relationship between the two extraction steps, and that they are clearly taking place in different hardware elements without any matching or mapping between the two.

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Regarding Claim 1 rejection for using “unclear difference between predetermined information and metadata”

The Applicants agree with the Examiner’s assessment that Claim 1 is slightly ambiguous with respect to the relationship and differences
15 between the extracted information and the metadata. In order to increase claim readability and to address all of the Examiner’s concerns regarding how the extracted information and the metadata are related to each other, the Applicants have amended independent Claim 1 to clarify exactly where the predetermined information is extracted from and how it is used
20 to automatically extract metadata from the files, without affecting the scope of the claims.

Therefore, in order to increase claim readability and to clarify where the predetermined information is extracted from, the Applicants amended
25 Claim 1, line 9 to include the phrase “from the files.” The Applicants submit that part (iii) of Claim 1 has been amended to read as follows: iii) said second processing element is configured to receive said files and extract predetermined information from the files.

30 Furthermore, in order to further clarify the distinction and relationship between predetermined information and metadata, the Applicants

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amended Claim 1, lines 11 and 12 to include the phrase “by employing the extracted predetermined information and the input from the database.”

The Applicants submit that part (vi) of Claim 1 has been amended to read as follows: vi) said reasoning element is configured to employ a set of rules to automatically extract metadata from the files by employing the extracted predetermined information and the input from the database. The Applicants further refer the Examiner to page 2 of this response, where a new listing of Claim 1 is provided containing the after mentioned amendments.

The Applicants submit that the new amendments to Claim 1 provide a clear and precise difference between the “predetermined information” and the “metadata,” and that this clear and precise difference is now disclosed in Claim 1. The Applicants further refer the Examiner to Claim 1 where it is now clearly disclosed that a second processing element (Specification Figure 1 element 106, and Claim 1 part iii)) is configured to receive said files and to extract “predetermined information” (Specification Figure 1 element 108) from the files (Specification Figure 1 element 104) and then provide the extracted predetermined information to a reasoning element (Specification Figure 1 element 110, and Claim 1 part vi)), wherein the reasoning element employs a set of rules (Specification Figure 1 element 114) to automatically extract “metadata” (Specification Figure 1 element 116) from the “predetermined information” (Specification Figure 1 element 108) extracted from the files by employing the extracted predetermined information and the input from the database (Specification Figure 1 element 104). Therefore, the Applicants submit that there is a clear and precise difference between the “predetermined information” and the “metadata” clearly disclosed in Claim 1, since the “predetermined information” is used to extract the “metadata” (Specification page 7 lines 11-19).

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In light of the amendments and the remarks made above, the Applicants believe Claim 1 to be allowable in its present form, and respectfully request that this rejection of Claim 1 under the second paragraph of 35 U.S.C. § 112 be withdrawn.

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Rejection of Claim 1 under 35 U.S.C. § 112, for “no nexus between the intended use of the preamble and the body of the claims”

The Examiner stated that there appears to be no nexus between the intended use of the preamble “for automatically extracting metadata” and the body of the claims in order to realize the preamble. The Examiner further stated that in Claims 1, and 9, the body of the claim is only directed to “extracting metadata” and not to “automatically” provide this functionality as suggested by the preamble. The Examiner further stated that the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention. *See* MPEP 2111.02 [II].

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Regarding Claim 1 rejection for using “no nexus between the intended use of the preamble and the body of the claims”

In order to improve claim readability and to address all of the Examiner’s concerns regarding how the present invention automatically extracts metadata, and in order to ensure that the body of the claim is directed to “automatically extracting metadata” as suggested by the preamble, the Applicants have amended independent Claim 1 to clarify exactly where the predetermined information is extracted from and how it is used to automatically extract metadata from the files, without changing the scope of the claims. As previously stated and repeated here for clarity, the Applicants have amended Claim 1 part (vi) to read as follows: vi) said reasoning element is configured to employ a set of rules to automatically extract metadata from the files by employing the extracted predetermined information and the input from the database. The Applicants further refer the Examiner to page 2 of this response, where a new listing of Claim 1 is provided containing the after mentioned amendments.

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In light of the amendments and the remarks made above, the Applicants believe Claim 1 to be allowable in its present form, and respectfully request that this rejection of Claim 1 under the second paragraph of 35 U.S.C. § 112 be withdrawn.

Rejection of Claims 2-16 under 35 U.S.C. § 112

With respect to Claims 9-16, the Examiner stated that independent Claim 9 carries the same deficiencies as Claim 1, and that Claims 2-8, and 10-16, are dependent upon independent Claims 1 and 9, respectively, and that Claims 2-8, and 10-16 carry the same deficiencies as Claims 1 and 9.

Regarding Claim 9 rejection for using “unclear difference between predetermined information and metadata, and no nexus between the intended use of the preamble and the body of the claims”

The Applicants agree with the Examiner’s assessment that Claim 9 is slightly ambiguous with respect to the relationship and differences between the extracted information and the metadata. In order to increase claim readability and to address all of the Examiner’s concerns regarding how the extracted information and the metadata are related to each other, the Applicants have amended independent Claim 9 to clarify exactly where the predetermined information is extracted from and how it is used to automatically extract metadata from the files, without changing the scope of the claims.

Therefore, in order to clarify where the predetermined information is extracted from, the Applicants amended Claim 9, line 9 to include the phrase “from the files.” The Applicants submit that part (c) of Claim 9 has been amended to read as follows: c) employing said second processing element to receive said files and extract predetermined information from the files.

Furthermore, in order to further clarify the distinction and relationship between predetermined information and metadata, the Applicants amended Claim 9, lines 13 and 14 to include the phrase “by employing the extracted predetermined information and the input from the database.”

The Applicants submit that part (f) of Claim 9 has been amended to read as follows: f) employing a set of rules in said reasoning element to automatically extract metadata from the files by employing the extracted predetermined information and the input from the database. The

Applicants further refer the Examiner to page 4 of this response, where a new listing of Claim 9 is provided containing the after mentioned amendments.

Please note that the previously proposed amendments to Claim 9 have been made in order to correct typographical and antecedent basis issues and do not affect the scope of the claim. Furthermore, some of these amendments have been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those skilled in the art to clearly understand the scope of the claim language.

In light of the amendments and the remarks made above, the Applicants believe Claim 9 to be allowable in its present form, and respectfully request that all rejections of Claim 9 under the second paragraph of 35 U.S.C. § 112 be withdrawn.

Rejection of Claims 2-16 under 35 U.S.C. § 112

In light of the amendments and the remarks made above regarding Claims 1 and 9, the Applicants believe Claims 1 and 9 to be allowable in their present form. Furthermore, Claims 2-8 are dependent upon Claim 1 and Claims 10-16 are dependent upon Claim 9. Therefore, the Applicants submit that Claims 2-8 and 10-16 are also patentable over the cited prior

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art at least based on their dependence upon an allowable base claim, and respectfully request that these rejections of Claims 2-16 under the second paragraph of 35 U.S.C. § 112 be withdrawn.

5 **Rejection of Claims 2 and 10 under 35 U.S.C. § 112, for using the phrase “such as”**

Regarding Claims 2 and 10, the Examiner rejected Claims 2 and 10, for using the phrase “such as” which renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. *See* MPEP § 2173.05(d). The Examiner further stated that Claims 2 and 10 should be amended to recite more definite
10 language, and the Examiner suggested that the phrase “such as” should be deleted from these claims to improve the clarity and the precision of the language.

In response to the Applicants’ arguments filed on July 5, 2006 and March 6, 2006, the Examiner stated that the Applicants’ remarks provided “such as” to be equivalent to
15 “substantially,” and the Examiner stated that “if that’s the case, such language should be used instead to be more clear and precise.” *See* MPEP 2173.02 and 2173.03.

Regarding Claims 2 and 10 rejection for using “such as”

In order to improve the clarity and the precision of the claim language, the
20 Applicants amended Claims 2 and 10, line 12 by deleting the phrase “such as Postscript files.” The Applicants refer the Examiner to pages 2 and 4 of this response, where a new listing of Claims 2 and 10, respectively, is provided containing the after mentioned amendments.

25 Please note that the previously proposed amendments to Claims 2 and 10 have been made in order to increase claim readability, to improve grammar, and to reduce the time and effort required of those skilled in the art to clearly understand the scope of the claim language. The Applicants submit that the proposed amendments do not affect the scope of the
30 claims.

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In light of the amendments and the remarks made above, the Applicants believe Claims 2 and 10 to be allowable in their present form, and respectfully request that all rejections of Claims 2 and 10 under the second paragraph of 35 U.S.C. § 112 be withdrawn.

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Claim Rejections - 35 USC § 102(b)

The Examiner rejected Claims 1-16 under 35 U.S.C. § 102(b) as being anticipated by Mahoney et al. (US Pat. No. 5,999,664), herein referred to as the "Mahoney patent".

10 **Rejection of Claim 1 under 35 U.S.C. § 102(b)**

In particular, the Examiner stated that the Mahoney patent discloses an apparatus for automatically extracting metadata from electronic documents comprising a first processing element, a second processing element, a reasoning element, and a database. The Examiner stated that the Mahoney patent further teaches that said first processing element is further configured to convert electronic documents into files (referring to column 7, lines 43-53), and that said first processing element is configured to provide the files to a second processing element (referring to column 5, lines 23-36).

20 Next, the Examiner stated that the Mahoney patent teaches that said second processing element is configured to receive said files and extract predetermined information (referring to column 4, lines 46-58, and column 8, lines 10-24), and that said second processing element is further configured to provide said extracted predetermined information to said reasoning element (referring to column 8, lines 41-51). Then, the Examiner stated that the Mahoney patent discloses that said database is configured to also provide input to said reasoning element (referring to column 8, lines 53-65), that said reasoning element is configured to use a set of rules to extract metadata from the files (referring to column 4, lines 46-58; column 9, lines 19-31; and column 10, Table 1, which shows "Rules"), and that the reasoning
30 element provides an output of metadata (referring to column 9, lines 32-51).

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With regards to the Applicants' response, filed on July 5, 2006 and March 6, 2006, where the Applicants submitted that "the present invention automatically extracts metadata from electronic documents in contrast to the Mahoney patent," the Examiner stated that "there is no recitation of the word automatically in the body of the claim as suggested by the

5 Applicant's remarks on page 11." The Examiner further stated that "in fact, the addition of *automatically* would provide accuracy and clarity of the invention in light of the preamble and the arguments.

The Examiner further stated that "the metadata taught by the Mahoney patent (referring

10 to column 8, lines 39-51, and column 9, lines 19-31) is dynamically provided either at time prior the scanning or after and such any documents are scanned, falling under the rules can have its metadata automatically extracted (as argued) or just merely extracted (manually as the claim language suggests)." Next, the Examiner stated that "there's no suggestion in the claims that the metadata is not provided previously by the user prior to

15 running the current process."

In response to Applicant's request that the Examiner indicated exactly where in the Mahoney patent is the limitation "second processing element is configured to provide said extracted predetermined information to said reasoning element, and said reasoning

20 element is configured to use a set of rules to extract metadata" is found, the Examiner stated that "the request is acknowledged but not deemed to be persuasive."

The Examiner further contended that the Mahoney patent in its entirety and more specifically in column 21, lines 1-17, and column 26, lines 25-39 discloses the argued

25 limitation, wherein pattern matching and similarity features are clearly taught. The Examiner stated that the Mahoney patent is directed to searching a corpus of document images specified document layout components, which are essentially specified feature information (Data that is used to describe other data= metadata) and spatial rules sought after, for match.

30 **Regarding Claim 1 rejection under 35 U.S.C. § 102(b)**

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5 In the Final Office Action, dated October 6, 2006, the Examiner rejected Claims 1-16 under 35 U.S.C. 102(b) as being anticipated by the Mahoney patent. However, the Applicants have submitted with this Request for Continued Examination (RCE) a new set of amended claims, which the Applicants believe overcome the art cited by the Examiner.

10 Please note that the previously proposed amendments to Claims 1 and 9 have been made in order to increase claim readability, to improve grammar, and to reduce the time and effort required of those skilled in the art to clearly understand the scope of the claim language. These proposed amendments do not affect the scope of the claims. The Applicants believe that these proposed amendments properly address all the concerns previously presented by the Examiner during the Final Office Action, dated October 6, 2006.

15 Regarding the Examiner's statement that "there is no recitation of the word automatically in the body of the claims," the Applicants refer the Examiner to page 2 and 4 of this response, where Claims 1 and 9, respectively, have been amended to recite "to automatically extract metadata from the files by
20 employing the extracted predetermined information and the input from the database."

25 Regarding the Examiner's statement that "there's no suggestion in the claims that the metadata is not provided previously by the user prior to running the current process," the Applicants strongly disagree with this Examiner's statement, since **the preferred embodiment and the root claims of the present invention is completely dedicated to automatically extracting metadata from electronic documents without any user interaction.** The Applicants believe that the Examiner has miss
30 read the present invention, and the Applicants hope that with the new amendments to the claims, the claims will become more clear and precise.

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5 The Applicants emphasize that the disclosed apparatus comprises a reasoning element that employs a set of rules to automatically extract metadata from files by employing extracted predetermined information and input from a database, and that this apparatus outputs the automatically extracted metadata.

10 The Applicants submit that the present invention automatically (without user intervention) extracts metadata from electronic documents (as disclosed in Claims 1-16 of the Specification), while the Mahoney patent is a user interactive system that depends on a user providing the system with specific features of the documents, such as the layout components and structures of objects within the electronic documents, in order for the Mahoney patent to function properly (referring to the Abstract). **The Mahoney patent discloses a document search system that provides a**
15 **user with a programming interface for dynamically specifying features of documents, and for interactive user specification of layout components and structures of documents** (emphasis added). The Applicants further submit that the Mahoney patent is responsive to commands from a user, wherein a user can manually specify properties of
20 document images which are recorded in a file system such as document metadata (referring to column 8 lines 39-51, and column 9 lines 19-31). Furthermore, the Applicants submit that the Mahoney patent teaches that the document metadata may be specified by a user at the time, or some time after, a document image is scanned or otherwise added to the file
25 system (referring to column 9 lines 19-31). In contrast, the present invention automatically extracts metadata from electronic documents by using a reasoning element which uses a set of rules to automatically extract metadata from the files by employing the extracted predetermined information and the input from the database (Claim 1 line 13 and Claim 9
30 lines 13-14).

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The Applicants emphasize that even the Examiner stated (on page 11 paragraph 3 of the Final Office Action dated October 6, 2006) **that “the metadata taught by the Mahoney patent** (referring to column 8, lines 39-51, and column 9, lines 19-31) **is dynamically provided** either at time prior the scanning, or after and such any documents are scanned.”

Therefore, the Applicants submit that metadata is provided to the Mahoney system by either a user or other means, but the Mahoney patent does not automatically extract the metadata on its own, since the metadata is being dynamically provided to the Mahoney system in order to function properly.

Regarding the Examiner’s statement that “the request is acknowledged but not deemed to be persuasive” concerning the Applicant's request that the Examiner indicated exactly where in the Mahoney patent is the limitation “second processing element ..., and reasoning element ...” is found, the **Applicants respectfully remind the Examiner that in order for the Examiner to establish a prima facie case of anticipation the Examiner must set forth a single reference that teaches or enables each of the claimed elements (as arranged in the claim)** either expressly or inherently and as interpreted by one of ordinary skill in the art. The Applicants further refer the Examiner to the Federal Circuit which stated that under 35 U.S.C. § 102(b), “There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention” *Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1576 (Fed. Cir. 1991). The Federal Circuit further stated that “Anticipation requires that every element of the claims appear in a single reference ...” *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). Thus, “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Furthermore, the Federal Circuit stated that under 35 U.S.C. § 102,
“anticipation requires the presence in a single prior art reference disclosure
of each and every element of the claimed invention, arranged as in the
claim” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick*
5 *Co.*, 730 F.2d 1452 (Fed. Cir. 1984).

Therefore, in order to establish a prima facie case of anticipation the
Examiner must set forth an argument that provides (1) a single reference
10 (2) that teaches or enables (3) each of the claimed elements (as arranged in
the claim) (4) either expressly or inherently and (5) as interpreted by one
of ordinary skill in the art. All of these factors must be present, or a case
of anticipation is not met.

Thus, the Applicants submit that the Mahoney patent, in combination with
the knowledge of one skilled in the art, does not teach, disclose or suggest
expressly or inherently all of the claim limitations of Claims 1 and 9 as
arranged in Claims 1 and 9.

The Applicants submit that there are significant differences between the
claimed invention and the Mahoney patent as viewed by a person of
ordinary skill in the field of extraction of metadata from electronic
documents. The Applicants submit that the present invention
automatically (without user intervention) extracts metadata from
25 electronic documents (as disclosed in Claims 1-16 of the Specification),
while the Mahoney patent is a user interactive system that depends on a
user providing the system with specific features of the documents, and that
the Mahoney patent provides a user with a programming interface for
dynamically specifying features of documents, and for interactive user
30 specification of layout components and structures of documents (emphasis
added).

Furthermore, independent Claim 1 of the present invention recites the limitation that “second processing element is configured to provide said extracted predetermined information to said reasoning element, and said reasoning element is configured to employ a set of rules to automatically extract metadata from the files by employing the extracted predetermined information and the input from the database.” The Applicants submit that this limitation is not taught, disclosed, or suggested in the Mahoney patent. Specifically, as stated in the abstract of the Mahoney patent, the Mahoney patent teaches a user interactive system that depends on a user providing the system with specific features of the documents in order for the Mahoney patent to function properly, in contrast with the reasoning element of the present invention, wherein the reasoning element uses a set of rules to automatically extract metadata and provides an output of metadata from files (Claim 1 lines 13-17).

Therefore, the Applicants firmly believe that the Examiner must indicate exactly where in the Mahoney patent does the Examiner find that the limitation “second processing element is configured to provide said extracted predetermined information to said reasoning element, and said reasoning element is configured to employ a set of rules to automatically extract metadata from the files by employing the extracted predetermined information and the input from the database” **is taught, disclosed, or suggested, in order for the Examiner to establish a prima facie case of anticipation.**

In light of the amendments and the remarks made above, the Applicants submit that the Mahoney patent, in combination with the knowledge of one skilled in the art, does not teach, disclose or suggest expressly or inherently all of the claim limitations of Claim 1 as arranged in Claim 1.

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Because the Mahoney patent fails to teach all the elements of Claim 1, arranged exactly as in Claim 1, for reasons discussed above, the Applicants respectfully request that the Examiner withdraw this rejection of Claim 1 under 35 U.S.C. § 102(b).

5

Rejection of Claims 2 and 10 under 35 U.S.C. § 102(b)

Regarding Claims 2 and 10, the Examiner stated that the Mahoney patent discloses an apparatus for automatically extracting metadata from electronic documents, wherein said files are substantially format invariant data files such as Postscript files (referring to column 14, lines 11-44, and column 1, lines 34-37).

10

Regarding Claims 2 and 10 rejection under 35 U.S.C. § 102(b)

Regarding Claims 2 and 10, the Applicants refer the Examiner to page 32 this response.

15

Rejection of Claims 3 and 11 under 35 U.S.C. § 102(b)

Regarding Claims 3 and 11, the Examiner stated that the Mahoney patent discloses that wherein said predetermined information is substantially spatial layout facts (referring to column 5 lines 46-61).

20

Regarding Claims 3 and 11 rejection under 35 U.S.C. § 102(b)

Regarding Claims 3 and 11, the Applicants refer the Examiner to page 32 this response.

25

Rejection of Claims 4 and 12 under 35 U.S.C. § 102(b)

Regarding Claims 4 and 12, the Examiner stated that the Mahoney patent discloses that wherein the second processing element and said database simultaneously input to the reasoning element (referring to column 2 lines 4-16).

30

Regarding Claims 4 and 12 rejection under 35 U.S.C. § 102(b)

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Regarding Claims 4 and 12, the Applicants refer the Examiner to page 32 this response.

Rejection of Claims 5 and 13 under 35 U.S.C. § 102(b)

5 Regarding Claims 5 and 13, the Examiner stated that the Mahoney patent discloses that wherein said set of rules can be updated (referring to column 2 lines 17-36), wherein “set of rules” reads on genre or “predefined form,” (referring to Figure 9 element 990).

10 **Regarding Claims 5 and 13 rejection under 35 U.S.C. § 102(b)**

Regarding Claims 5 and 13, the Applicants refer the Examiner to page 32 this response.

Rejection of Claims 6 and 14 under 35 U.S.C. § 102(b)

15 Regarding Claims 6 and 14, the Examiner stated that the Mahoney patent discloses that wherein said metadata is substantially comprised of title, author, affiliation, author affiliation, and table of contents (referring to column 4 lines 47-56, and column 9 lines 23-31).

20 **Regarding Claims 6 and 14 rejection under 35 U.S.C. § 102(b)**

Regarding Claims 6 and 14, the Applicants refer the Examiner to page 32 this response.

Rejection of Claims 7 and 15 under 35 U.S.C. § 102(b)

25 Regarding Claims 7 and 15, the Examiner stated that the Mahoney patent discloses that wherein said metadata is provided to a user interface (referring to Figure 7).

Regarding Claims 7 and 15 rejection under 35 U.S.C. § 102(b)

30 Regarding Claims 7 and 15, the Applicants refer the Examiner to page 32 this response.

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Rejection of Claims 8 and 16 under 35 U.S.C. § 102(b)

Regarding Claims 8 and 16, the Examiner stated that the Mahoney patent discloses that wherein said metadata is provided to a storage medium (referring to Figure 2).

5 **Regarding Claims 8 and 16 rejection under 35 U.S.C. § 102(b)**

Regarding Claims 8 and 16, the Applicants refer the Examiner to page 32 this response.

Rejection of Claim 9 under 35 U.S.C. § 102(b)

10 Regarding Claim 9, the Examiner stated that the Mahoney patent discloses a method for automatically extracting metadata from electronic documents comprising a first processing element, a second processing element, a reasoning element, and a database. The Examiner stated that the Mahoney patent discloses the steps of using said first processing element to convert electronic documents into files (referring to
15 column 7, lines 43-53), and further using said first processing element to provide the files to a second processing element (referring to column 5, lines 23-36).

Next, the Examiner stated that the Mahoney patent discloses the steps of using said second processing element to receive said files and extract predetermined
20 information (referring to column 4, lines 46-58, and column 8, lines 10-24), and further using second processing element to provide said extracted predetermined information to said reasoning element (referring to column 8, lines 41-51). The Examiner further stated that the Mahoney patent discloses the steps of using said database to provide input to said reasoning element (referring to column 8, lines
25 53-65), using a set of rules in said reasoning element to extract metadata from the files (referring to column 4, lines 46-58, and column 9, lines 19-31), and providing an output of metadata from said reasoning element (referring to column 9, lines 32-51).

30 **Regarding Claim 9 rejection under 35 U.S.C. § 102(b)**

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Regarding Claim 9, the Applicants refer the Examiner to comments above concerning Claim 1. The Applicants submit that independent Claim 9 of the present invention recites the limitation that “employing said second processing element to provide extracted predetermined information to said reasoning element, and employing a set of rules in said reasoning element to automatically extract metadata from the files by employing the extracted predetermined information and the input from the database.”

The Applicants submit that this limitation is not taught, disclosed, or suggested in the Mahoney patent. Specifically, as stated in the abstract of the Mahoney patent, the Mahoney patent teaches a user interactive system that depends on a user providing the system with specific features of the documents in order for the Mahoney patent to function properly, in contrast with the reasoning element of the present invention, wherein the reasoning element uses a set of rules to automatically extract metadata and provides an output of metadata from files (Claim 9 lines 16-19).

The Applicants respectfully request that the Examiner indicate exactly where in the Mahoney patent does the Examiner find that the limitation “employing said second processing element to provide extracted predetermined information to said reasoning element, and employing a set of rules in said reasoning element to automatically extract metadata from the files by employing the extracted predetermined information and the input from the database” is taught, disclosed, or suggested.

In light of the amendments and the remarks made above, the Applicants submit that the Mahoney patent, in combination with the knowledge of one skilled in the art, does not teach, disclose or suggest expressly or inherently all of the claim limitations of Claim 9 as arranged in Claim 9.

Because the Mahoney patent fails to teach all the elements of Claim 9, arranged exactly as in Claim 9, for reasons discussed above, the

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Applicants respectfully request that the Examiner withdraw this rejection of Claim 9 under 35 U.S.C. § 102(b).

5

DEPENDENT CLAIMS

Claims 2-8 are dependent upon Claim 1 and Claims 10-16 are dependent upon Claim 9.

The Applicants respectfully refer the Examiner to the comments above regarding Claims 1 and 9. For at least the reasons given above, the Applicants submit that Claims 1 and 9 are patentable over the cited prior art. Therefore, the Applicants submit that Claims 2-8 and 10-16 are also patentable over the cited prior art at least based on their dependence upon an allowable base claim.

10

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Closing Remarks:

The Applicants respectfully submit that, in light of the above amendments/remarks, the application and all pending claims are now in allowable condition. Therefore, reconsideration is respectfully requested. Accordingly, early allowance and issuance of
5 this application is respectfully requested.

Any claim amendments that are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather,
10 these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those skilled in the art to clearly understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes of any cancelled claims. They are simply additional specific statements of
15 inventive concepts described in the application as originally filed.

Further, it should be noted that amendment(s) to any claim is intended to comply with the requirements of the Office Action in order to elicit an early allowance, and is not intended to prejudice Applicant's rights or in any way to create an estoppel preventing
20 Applicant from arguing allowability of the originally filed claim in further off-spring applications.

In the event the Examiner wishes to discuss any aspect of this response, or believes that a conversation with either Applicant or Applicant's representative would be beneficial, the
25 Examiner is encouraged to contact the undersigned at the telephone number indicated below.

The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to the attached credit card form. In particular, if this response is not
30 timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of

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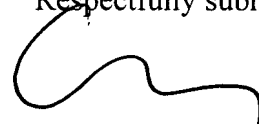
the number of months necessary to make this response timely filed. The petition fee due in connection therewith may be charged to deposit account no. 50-2738 if a credit card form has not been included with this correspondence, or if the credit card could not be charged.

5

4/6/07

10 Date

Respectfully submitted,



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